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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,293	10/31/2003	Samuel J. Lewis	HES 2003-IP-011770U1	1381

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EXAMINER

MARCANTONI, PAUL D

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/698,293

Applicant(s)

LEWIS ET AL.

Examiner

Paul Marcantoni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5/23/06 RCE.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5-12,14-30,34-40 and 87-113 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-12,14-30,34-40, and 87-113 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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The applicants' response filed 11/14/05 has been considered but it is not persuasive.

The applicants' amendment necessitated the new grounds of rejection below:

New Matter-Objection to the Specification:

The applicants deletion of co-surfactant, surfactant, anionic surfactant, etc. removed from the original disclosure would appear to be a new matter deletion. For instance, with respect to paragraph [0019], the original disclosure only required that the surfactant should be anionic and that in "certain exemplary embodiments, the anionic surfactant comprises a hydrolyzed protein or derivative thereof". The applicants have effectively narrowed the scope of their invention in, for example, [0019], by deleting "surfactant" (broadly anionic surfactant) and limiting the specification now to hydrolyzed protein. This narrowing of scope is a new matter deletion.

New Matter- Claims:

Newly added claims 87-113 are rejected under the first paragraph of 35 USC 112 and 35 USC 132 as the specification as originally filed does not provide support for the invention as is now claimed.

Applicants may easily resolve by pointing out the location of support for each claim from their original disclosure (specification and claims). Should they do so, this rejection will be promptly withdrawn. Note: Applicants still have not provided the location of original support for these newly added claims and this new matter rejection remains.

35 USC 112 Second Paragraph:

Claims 1,5-12,14-30,34-40, and 87-113 are rejected under 35 USC 112 second paragraph as failing to set forth the subject matter which applicants regard as their invention.

The term "desired" remains indefinite in claim 1 and now new claim 87. The term "low" density cement is indefinite in claim 24 and now new claim 109. Desired is synonymous to predetermined and its meaning is indefinite. The term "low" is a relative and indefinite term and applicants have not defined what they mean by "low" density cement by showing a numerical means so it is clear for the record.

Obviousness Type Double Patenting:

Claims 1,5-12,14-30,34-40, and 87-113 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 14 and 52 of US Patent Numbers 6,454,004 B2 (Reddy et al.) and US 6,793,730 B2 (Reddy et al.) alone or in view of Cattnach (US Patent No. 3,615,784 or FR 1550231).

This rejection remains. Applicants did not submit a proper terminal disclaimer.

35 USC 103:

Claims 1,5-12,14-30,34-40, and 87-113 are rejected under 35 USC 103(a) as being unpatentable over Sugama '395, Gay et al. '295 B1, Neely Jr. '661 B2, or Etherton (EP 1103533) alone or in view of Chatterji (US 5,897,699 or 6,063,738), Bour et al. (US 5,147,565), Cattnach (US Patent 3,615,784 or FR 1550231), Gopalkrishnan (US 5,252,128), or DiLullo Arias et al. (US 6,235,809 B1).

Response:

New Matter Objection to Specification:

The amendment filed 11/14/05 is considered new matter added to the specification because the originally filed invention taught that the surfactant in the dispersant compositions of the present invention should be anionic. The original specification did not narrow the scope of the invention to only hydrolyzed proteins as the anionic surfactant. Applicants' amendment effectively removes any other anionic surfactant which changes their originally disclosed invention. This narrowing of scope and deletion of all other anionic surfactants limiting it only to hydrolyzed proteins would appear to be a new matter deletion.

It is not disputed that hydrolyzed protein has original support. The point of contention is that applicants' amendment deletes the possibility of any other anionic surfactants which is all that was required of the original disclosure (see [0019]). The applicants did not originally file their disclosure to contain only hydrolyzed protein as the only anionic surfactant. In fact, the original disclosure even shows that it is only one example ("certain exemplary embodiments the anionic surfactant comprises a hydrolyzed protein. It would not appear permissible to delete the possible other anionic surfactants other than hydrolyzed proteins as this was not originally disclosed as their invention (ie only hydrolyzed protein). Thus, this is a new matter deletion and has not been entered.

New Matter-Claims:

The applicants have not provided the location of support for the previously newly added claims and this rejection shall persist until they show location of support for each newly added claim. Upon this showing, it is expected this rejection will be withdrawn.

35 USC 112 Second Paragraph:

The examiner maintains these terms are indefinite for the same reasons as previously presented in his earlier office actions such as the 1/25/06 final rejection. Please refer to it for rebuttal as it is the same.

35 USC 103:

The applicants now amend their claim to include the defoamer (an *optional* ingredient according to their own specification (see paragraph [0023] on p.7).

Nevertheless, the added use of a defoamer in a well cement composition would be notoriously known in the art and is routinely used as an obvious design choice for one of ordinary skill in the art. Should applicants seasonably challenge this assertion, the examiner respectfully provides the following references below which teach that the use of a defoamer in well cementing (and other cementing applications) is notoriously known in the art: (documented proof):

Chatterji (US Patent No. 6,297,202 B1) teaches polypropylene glycols are known defoamers in well cements (col.1 lines 49-50).

Chatterji et al. '844 teaches defoamers are old in the art as conventional additives to well cements (col.3, line 20).

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Mehta et al. '255 teach defoamers are known well cement additives (claim 5, col.16).

Mehta et al. '103 teach defoamers are known well cement additives (col.2, line 20).

Ludwig '632 teach that adding a defoaming agent to well cements is conventional in the art (col.5, lines 5-10).

JP 03008749 (Ohama et al.) teach adding a defoaming agent to well cements as a conventional and routinely used additive is old in the art.

EP 0475568 (Moran) teaches it is old in the art and optional (like applicants teaching) to add a defoamer to well cements.

It is also noted that the use of one known defoamer over another would have been an obvious design choice for one of ordinary skill in the art because the defoamers are functionally equivalent.

The applicants have allege and argue that the primary references are directed to *foamed* composition and it would appear that applicants hold the position that because these primary references teach foamed composition it is contrary to these references teachings and objectives. In other words, adding a foaming agent and defoaming agent together wouldn't occur. The examiner disagrees and refers applicants to their own Halliburton patent to Chatterji et al. '844 for well cements wherein they teach that adding both a defoaming agent and a foaming agent and even a foam stabilizer is old and known in the art (see col.3, lines 15-21 of Chatterji '844). It is thus not contrary to add

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both defoamer and foaming agent in the same cement composition including well cement compositions.

The applicants also argue Neely does not teach adding a protein in combination with a defoamer in a method of cementing. In rebuttal, applicants' claimed method of cementing is not directed to a method of cementing a "well" or "subterranean formation" so applicants method of cementing can read upon any method of cementing including a method of coating or cementing a substrate of stainless steel. While it is true that the claims may be read in light of the specification, it is improper to read the limitations of the specification into the claims. In re Yamato, 222 USPQ 93; In re Wilson, 149 USPQ 523; Graver Tank v. Linde Air Products Co. 80 USPQ 451 (Supreme Court). Applicants cannot read a method of cementing a well or subterranean formation because they do not provide this limitation in their claims.

Obviousness Type Double Patenting:

The applicants are again referred to the 1/25/06 final rejection (pages 7-8) as it provides the same arguments as to why the ODP rejection is proper. The only difference is applicants now amended their claim to include a defoamer in the independent claims. For the same reasons as stated, above, the use of a defoamer even together with a foaming agent and foam stabilizer is old in the art and the use of one or both would have been an obvious design choice for one of ordinary skill in the art. Applicants again are referred to their own Halliburton patent to Chatterji et al. '844 for well cements wherein they teach that adding both a defoaming agent and a foaming agent and even a foam stabilizer is old and known in the art (see col.3, lines 15-21 of



Chatterji '844). It is thus not contrary to add both defoamer and foaming agent in the same cement composition including well cement compositions.

This is an RCE of applicant's earlier Application No. 10/698,293. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni  
Primary Examiner  
Art Unit 1755